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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/004,017 | 10/18/2001 | Kenneth Allan Perrie | 1482/187(d) | 6405 |

23381 7590 08/26/2003

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EXAMINER

HARRISON, JESSICA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3714

DATE MAILED: 08/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,017

Applicant(s)

PERRIE ET AL.

Examiner

Jessica J. Harrison

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 36 – 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The last step of claim 36 appears to be incomplete and/or missing text. As presented, “ending the casino bonus game when the player in response to awarding the amount” does not make sense. Furthermore, there is a lack of antecedent basis for “the casino bonus game” as only a casino game has been defined. Given that the invention involves two games, clear distinction between the primary or underlying game and the bonus game is necessary to delineate which game applicant is claiming.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36, 39, 41, and 44- 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Cork (GB 2231189).

Regarding claims 52-56, these claims appear clearly anticipated given the following interpretation. Cork discloses a strategy-based casino bonus

game method for a player of a gaming machine (page 8, first paragraph) which is entered from an underlying fruit machine game. The player has at most a given number of player inputs (position selections) in that the player selects positions for the ball (page 8, 4th para). The player is awarded for each successful bonus game result during play of the game (each iteration of the game as target area is expanded and compared to player input results in appropriate awards (page 6 last para – page 7), the game ends when the given number of player inputs have occurred without obtaining an overall game solution(as well as with overall solution) and awarding the player based on the number of player inputs used to obtain the solution (closer “X’s” get higher awards- more than one “X” in circle increases award).

Regarding claims 36, 41 and 44 Cork fails to clearly state language of “compound hidden image” as set forth in the claims; Cork merely states the image is a ball. It is noted that Cork is illustrated with the game of (British) “football” which is also known as soccer. While not illustrated, it is commonly known that a soccer ball has two color areas – black and white, and that the image of the ball would be larger than a single pixel on the display screen. It obviously follows, therefore, that any representation of a soccer ball in Cork would be a “compound hidden image” when hidden in that it would be a number of patterns (black and white pixels) arranged and hidden from view. This is how the examiner interprets Cork to meet the claimed “compound hidden image” of these specific claims. Any claims not specifically discussed

are clearly shown in Cork. The reference is deemed to meet the claims as broadly claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37, 38, 39, 40, 42, 43, 57 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cork.

The difference between claims 37, 38, 57 and 58 and Cork lie in the recitation of plural hidden patterns, while Cork only clearly show/discusses one ball being hidden. However, the provision of multiple targets in the Cork game only serves to enhance the gaming experience and would further attract players. Furthermore, an image could be generated showing multiple players practicing their soccer “dribbling”, giving a player multiple targets to attempt and increasing their odds of winning. The provision of such would allow game designers to have greater control over the overall payout of the game machine – a necessary requirement for implementation in regulated gaming areas such as the United States. Therefore it would have

been obvious to one of ordinary skill in the art at the time of the invention to modify the game illustrated in Cork to include a plurality of hidden target patterns for a player to attempt to find in order to provide an attractive bonus game for players while meeting payout control regulations so that the game may be deployed on the gaming room floor.

The difference between Cork and instant claims 39 and 42 lies in recitation of a progressive jackpot payout. Cork fails to include a jackpot payout – a special award, for example, if a player makes a selection that is perfectly center of the hidden image. However, use of progressive jackpot payouts to attract players and increase play is notoriously well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the game illustrated in Cork to include a progressive jackpot payout for a perfect target hit, in order to attract more players to the game.

Claims 40 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cork as applied to claims 36 and 42 above, and further in view of Trend (GB 2105560).

Cork fails to explicitly teach a free game as a possible award in his spot-the-ball game. Trend discloses an analogous spot-the-ball game, and clearly discloses a free game as an award in col 1 lines 35 – 40. As awards are within the purview of game designers and are selected based upon design criteria, absent any unexpected advantage it would have been obvious to one of

ordinary skill in the art at the time of the invention to modify the game illustrated in Cork to include a free game award based upon appropriate criteria as such are commonly known as illustrated by Trend. Absent any unexpected advantage, provision of one type of award over another type of award does not serve to define patentability.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional art relates to similar games. Also, all prior art from this application's parent patent file has been reviewed and cited on the enclosed PTOL 892. Applicant's IDS of 5/22/02 has also been considered.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone number is 703-308-2217. The examiner can normally be reached on 8 hour/M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

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Art Unit: 3714

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A handwritten signature in black ink, appearing to read 'J. Harrison', with a large, stylized initial 'J'.

Jessica J. Harrison
Primary Examiner
Art Unit 3714

jjh